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(2)

IN THE
Supreme Court of the United States
OCTOBER TERM, 1996

SHELLEY K. COLE,
Petitioner,

v.

KIMBERLY-CLARK CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION OF RESPONDENT KIMBERLY-CLARK CORPORATION

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QUESTIONS PRESENTED

1. Whether the court of appeals erred in holding that the term "perforation," as used in petitioner's patent, should be construed in accordance with its ordinary, dictionary definition where neither the patent itself nor its prosecution history suggested any other definition.

2. Whether the court of appeals erred in holding that petitioner's repeated representations to the Patent and Trademark Office that her invention, disposable training pants, required "perforations," and that prior art products that used side seams to facilitate tearing and removal were distinguishable from her invention, estopped petitioner from later arguing that her invention did not require perforations and that her patent covered products with side seams that could be torn to facilitate removal.

3. Whether, on the facts of this case, the court of appeals correctly determined that the "detailed recitation" of structure in the "means . . . for tearing" element of petitioner's patent made that element ineligible for means-plus-function interpretation under 35 U.S.C. § 112, ¶ 6.

LIST OF AFFILIATES

Pursuant to Supreme Court Rule 29.6, the following are the non-wholly owned subsidiaries of respondent Kimberly-Clark Corporation:

Kimberly-Clark de Mexico, S.A. de C.V.

Kimberly-Clark Philippines, Inc.

Carlton Paper Corporation, Ltd.

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BRIEF IN OPPOSITION OF RESPONDENT KIMBERLY-CLARK CORPORATION

Kimberly-Clark Corporation ("K-C") respectfully submits this brief in opposition to the petition for a writ of certiorari filed by Shelley K. Cole. Because the decision below was a correct and straightforward application of settled principles of patent law to the specific facts of this case, this Court should deny the petition. First, contrary to petitioner's representations, the Federal Circuit did not adopt a "blanket rule" excluding all testimony on the meaning of patent terms; indeed, the court of appeals did not even mention the admissibility of testimony. The

Federal Circuit merely declined to give any weight to expert testimony that the district court properly described as internally inconsistent and of no probative value. Second, petitioner's assertion that prosecution history estoppel cannot arise from arguments made to the Patent and Trademark Office ("PTO") to obtain the issuance of a patent, but only from amendments to patent claims, has not been preserved for review by this Court and, in any event, is supported by neither precedent nor policy. The Federal Circuit has consistently held that prosecution history estoppel can arise from arguments made to the PTO, as well as from amendments to the claims, a conclusion that is fully consistent with the policy considerations that underlie the doctrine of prosecution history estoppel. Even if that conclusion were flawed, however, petitioner never asked the courts below to adopt a different rule, and cannot make such a request for the first time in this Court. Finally, petitioner's assertion that the Federal Circuit's application of 35 U.S.C. § 112, ¶ 6, was "contrary to many years of circuit court precedent" (Pet. i) does not withstand scrutiny. The Federal Circuit simply applied well-settled principles to the particular facts of this case. The Federal Circuit's decision was correct and, in any event, does not present any question worthy of this Court's attention.

COUNTERSTATEMENT OF THE CASE

Petitioner's statement of the case is inaccurate in many respects. Nevertheless, for present purposes, only three corrections need be made. First, petitioner mischaracterizes her representations to the Patent and Trademark Office, asserting that she distinguished prior art patents only in general ways when, in reality, she specifically and repeatedly emphasized that, unlike prior art patents, her invention—disposable training pants for children to wear during toilet training—utilized perforations but not tearable side seams to allow soiled training pants to be easily removed. Second, K-C did not begin developing its dis-

posable training pants in response to petitioner's December 1986 inquiry, as petitioner implies; rather, K-C had begun its development efforts over three years earlier, in May 1983. Third, the district court and the Federal Circuit did not announce any new rules of law, but rather rendered narrow, fact-bound, case-specific rulings. Although Judge Rader dissented from the majority's decision, he did so not because of any dispute about the law, but merely how it applied to this case. (*See* Pet. App. A19-21.)

1. In proceedings before the Patent and Trademark Office, petitioner repeatedly emphasized that, unlike prior art patents, her invention required perforations and did not have separable side seams. For example, petitioner responded to the initial rejection of her patent application as anticipated by the Roberts patent by, *inter alia*, distinguishing the side seams of the Roberts patent from the perforations of her own invention:

> It will be noted that the Roberts patent discloses overlapping edges at the sides between the waist bands and the leg bands, and the overlapping layers are stitched together. The stitched seams cannot be readily torn apart in the Roberts patent, but the apparatus of the present invention *utilizes perforations* to allow the training brief to be readily torn so as to expedite the removal of the training brief. It is respectfully submitted that this feature of the training briefs of the present invention is neither suggested nor taught by the Roberts patent.

(Pet. App. A8-9 (emphasis added).)

Petitioner again took the position that her invention could be distinguished from the prior art because it utilized perforations and not side seams in her two reexamination requests. In the first, petitioner distinguished K-C's Strohbeen patent—which disclosed a disposable training pant with sonically bonded, tearable side seams—by noting that "[t]he side seams of the [K-C] patent are

substantially different from the side seams of the instant patent." (Pet. App. A10; B12.) Petitioner also argued that another patent, the Repke patent, which also discloses a disposable brief that can be torn apart at the side seams to facilitate removal when soiled, was not "believed to be pertinent, structurally, to any of the claims" of her patent (*id.*, B12), which petitioner described as requiring "*perforations* extending through the outer impermeable layer between the waist band and the leg bands." (C.A. App. 396-97 (emphasis added).) In denying petitioner's reexamination request, and thus upholding her patent, the examiner held that the "essential features" of petitioner's claims—the configuration of the absorbent layers and the "perforation means"—"are not present in the cited patents." (Pet. App. A11.)

In January 1993, petitioner filed a second request for reexamination, referencing yet another patent for disposable training pants, the Heran patent, that had been issued to K-C employees. That patent specifically discloses disposable briefs with sonic-bonded side seams that permit the sides to be torn to facilitate removal. Petitioner told the PTO that the Heran patent was not "pertinent, structurally, to any of the claims" of her patent. (Pet. App. A12.) Petitioner again described her invention as requiring "*perforations* extending through the outer impermeable layer between the waist band and the leg bands." (C.A. App. 971 (emphasis added).) The examiner accepted her argument and concluded that neither of the essential features of petitioner's invention—the absorbent layers and the "perforation means"—was disclosed or suggested in the Heran patent. In particular, the examiner accepted petitioner's contention that the Heran patent's tearable, sonic-bonded side seams were not "perforation means": "although Heran et al does disclose the garment as having tearable side seams they do not include perforation means extending from the leg band means to the waist band means through the outer im-

permeable layer." (Pet. App. A12.) As the district court held, the K-C products that petitioner alleged infringed her patent utilize tearable, sonic-bonded side seams, and not perforations, to facilitate removal.

2. Contrary to the petition's implication, K-C did not begin to develop its disposable training pants in response to petitioner's December 1986 letter to K-C regarding her patent application. Rather, K-C, which has been a leading manufacturer and seller of disposable diapers for many years, had begun a multi-million dollar, six-year research and development effort to develop disposable training pants over three years earlier, in May 1983. (*See* Pet. App. A3.) That effort, which resulted in several patents, including the Strohbeen and Heran patents distinguished by petitioner in her reexamination requests, ultimately proved successful and, in 1989, K-C launched its Huggies Pull-Ups® disposable training pants, which petitioner contends infringe her patent.

3. Both courts below rendered very narrow, fact-bound decisions that announced no new rules of law. In granting K-C summary judgment on petitioner's patent infringement claims, the district court merely construed the "perforation means . . . for tearing" element in petitioner's patent claims. The district court concluded that the "only reasonable reading" of petitioner's "perforation means" element was that "the sides of her invention tear by means of a perforation." (Pet. App. C7.) The district court rejected petitioner's contention that "perforation means" had a broader meaning, finding that contention unsupported by the probative evidence and contrary to the ordinary meaning of the claim language. The district court specifically held that petitioner's experts' testimony was not probative, noting that "their conclusions [were] not internally consistent with their own testimony." (Pet. App. C8; *see also id.*, B9-11.)

Because it held that petitioner's patent required perforations, but that K-C's products did not use perforations, the

district court held that there was no literal infringement. (Pet. App. C7-8.) The district court also held that petitioner's arguments to the PTO estopped her from claiming that products with tearable side seams, such as K-C's training pants, contained "perforation means" (*id.*, B11) and that ultrasonically bonded side seams, such as those in K-C's products, could be "perforation means" (*id.*, B12-13). Petitioner's claim that K-C's products infringed under the doctrine of equivalents was thus rejected.

In affirming these rulings, the Federal Circuit held that "there is no evidence to suggest that 'perforation' has any meaning other than the dictionary definition accepted by the [district] court." (Pet. App. A14.) The majority also held that the "means . . . for tearing" element of petitioner's patent claims includes "such a detailed recitation of . . . structure" that it could not be interpreted as a means-plus-function element for purposes of 35 U.S.C. § 112, ¶ 6. (Pet. App. A14.) Because none of K-C's accused products uses perforations, the Federal Circuit affirmed the district court's holding that there was no literal infringement. (*Id.*, A16.) The Federal Circuit further held that petitioner's arguments to the PTO estopped her from claiming that K-C's products—which have no perforations and which use ultrasonically bonded side seams—infringe her patent under the doctrine of equivalents. (*Id.*, A17.)

REASONS FOR DENYING THE PETITION

The petition presents no question worthy of this Court's review. The petition's first question—whether a blanket rule excluding testimony concerning the meaning of patent terms is appropriate—finds no basis in the Federal Circuit's opinion, which does not even discuss the admissibility of testimony, let alone adopt any exclusionary rule. In the petition's second question, petitioner argues that this Court should adopt a new rule of law concerning prosecution history estoppel. Petitioner waived this argument by not pre-

senting it below, and, in any event, the rule that she seeks is supported by neither precedent nor policy. The petition's third question simply seeks reversal of the Federal Circuit's determination that, as used in petitioner's patent, the term "perforation means . . . for tearing" does not qualify for interpretation as a means-plus-function element. The Federal Circuit's holding is a fact-specific ruling that is not in conflict with the decision of any other court. The petition should be denied.

1. Petitioner's assertion that the Federal Circuit adopted a "blanket rule" excluding all testimony concerning the meaning of terms used in a patent claim is pure fantasy. Nothing in the Federal Circuit majority's opinion, or in the dissent, suggests that such a rule was applied in this case, or that such a rule exists. Petitioner presented her expert testimony to the district court without objection from K-C (*see* Pet. 8-9), and the district court considered that testimony (*id.*, 9). The district court found the testimony to be internally inconsistent and without probative value (*see* Pet. App. C8; *id.*, B9-11), but did not exclude it and certainly did not apply a "blanket rule" of exclusion. The admissibility of petitioner's expert testimony was not challenged by K-C on appeal, and petitioner concedes that the Federal Circuit did not expressly exclude it (Pet. 10). This Court will search the opinions below in vain for any sign of petitioner's "blanket rule."

Petitioner purports to find that rule in what the Federal Circuit did not say, rather than in what it said. In particular, petitioner points to the court's failure to mention her experts' testimony in the course of reaching its conclusion that there was "no evidence to suggest that 'perforation' has any meaning other than the dictionary definition accepted by the [district] court." (Pet. App. A14.) According to petitioner, the only explanation for the court's conclusion that there was "no evidence" is that a blanket rule excluding testimony must have been applied. But peti-

tioner simply ignores the district court's conclusion that the testimony of her experts was of no probative value—a conclusion she does not expressly challenge in this Court. Petitioner goes on to speculate that, even though the Federal Circuit's opinion did not cite that court's prior decision in *Vitronics Corp.* v. *Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), the majority nevertheless was "apparently relying on it" in this case. (Pet. 9.)[1] Petitioner then asserts that *Vitronics* announces the "blanket rule" that she challenges and devotes the remainder of her argument on this issue to tilting at the *Vitronics* windmill.

As an initial matter, certiorari should not be granted to address a rule of law neither considered nor applied in the case at hand. *See The Monrosa* v. *Carbon Black Export, Inc.*, 359 U.S. 180, 184 (1959) (certiorari improvidently granted where issue was posed only abstractly). Moreover, even if the "blanket rule" had been applied in this case (and it was not), this case would be an inappropriate vehicle for this Court to use to consider the propriety of that rule because, in light of the fact that petitioner's expert testimony lacked any probative value, whether or not that testimony was excluded would make no difference to the outcome of this case.

In any event, contrary to petitioner's characterization, *Vitronics* does not create "a per se exclusionary rule." (*See* Pet. 9.) Rather, *Vitronics* merely applies the well-settled principle, reaffirmed by this Court in *Markman* v. *Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996), that the patent and its prosecution history—the written public record—are to be the primary sources for claim construction and that extrinsic evidence is to be considered only in those rare instances in which the meaning of claim language cannot be discerned from those documents. *Vitronics*, 90 F.3d at 1582-83; *see Markman*, 116 S. Ct. at 1395.

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[1] Neither K-C nor petitioner cited *Vitronics* in the courts below.

In *Vitronics*, the Federal Circuit rejected the attempted use of expert testimony to contradict the claim construction dictated by the patent documents. *Id.* at 1584. To the extent that the Federal Circuit implicitly said anything at all about expert testimony in the instant case, it merely rejected petitioner's attempt to use expert testimony to contradict the meaning of "perforation" that appeared from the patent documents. *See also Southwall Technologies, Inc.* v. *Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir.), *cert. denied*, 116 S. Ct. 515 (1995). Petitioner may disagree with the Federal Circuit's construction of her patent and its prosecution history, but that disagreement presents an inherently case-specific question that does not implicate either Federal Rule of Evidence 702 or *Daubert* v. *Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993), and does not warrant certiorari.

2. With her second question, petitioner asks this Court to announce a new rule of law: that prosecution history estoppel can arise only from an amendment to a patent claim, and not from arguments presented to the Patent and Trademark Office. As an initial matter, petitioner has waived this argument. Neither in the district court nor in the court of appeals did petitioner suggest that, as a matter of law, prosecution history estoppel cannot arise in the absence of an amendment to a patent's claims. To the contrary, petitioner conceded below that an estoppel could be found where the patentee had made "clear" or "unmistakable" representations to the PTO and argued only that such representations had not been made in this case. (*See* Pet. App. B10, n.3; Petitioner's Brief to the Federal Circuit, pp. 40, 42; Petitioner's Reply Brief to the Federal Circuit, pp. 3, 15, 17.) Petitioner cannot change her theory at this late date.[2]

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[2] This is not a case in which the issue petitioner seeks to present arose for the first time as a result of the ruling of the court of appeals. The district court had squarely held that petitioner's argu-

Moreover, petitioner's proposed rule is supported by neither precedent nor policy. The Federal Circuit has consistently held that prosecution history estoppel can arise from arguments presented to the examiner, as well as from amendments to the claims. *E.g.*, *Hughes Aircraft Co.* v. *United States*, 717 F.2d 1351, 1362 (Fed. Cir. 1983).[3] Indeed, even Judge Rader in dissent did not question the general rule that an estoppel may arise from patentee arguments. Rather, Judge Rader dissented because he considered the record with respect to petitioner's representations to the PTO to be "ambiguous" as a factual matter. (Pet. App. A21.)

Nothing in this Court's recent decision in *Warner-Jenkinson Co.* v. *Hilton Davis Chemical Co.*, 117 S. Ct. 1040 (1997), suggests that this Court was implicitly changing this well-settled principle. Petitioner sees in

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ments to the PTO had created an estoppel, so the amendment vs. argument issue petitioner now seeks to raise could and should have been presented to the court of appeals.

[3] Citing 5 Donald S. Chisum, *Patents* § 18.05[2][c] (1997), petitioner contends that "[b]efore the creation of the Federal Circuit in 1982, the courts of appeals were in conflict as to whether prosecution history estoppel could be based on attorney argument." (Pet. 14-15.) Although Professor Chisum does cite several decisions that apparently held that prosecution history estoppel could not be based on attorney arguments, the most recent of them was decided in 1944. *See* 5 Chisum at § 18.05[2][c], p. 18-169, n.16 (citing *Katz* v. *Horni Signal Mfg. Corp.*, 145 F.2d 961 (2d Cir. 1944), *cert. denied*, 324 U.S. 882 (1945)). As Professor Chisum's further discussion makes clear, the view of most of the courts that considered the question and the view of virtually all of the courts that considered the question during the nearly 40 years between the decision in *Katz* and the creation of the Federal Circuit was that patentee arguments to the PTO can give rise to prosecution history estoppel. *See* 5 Chisum at § 18.05[2][c], pp. 18-172 to 18-175. And, as petitioner readily concedes (Pet. 15-16, 25 n.7), the Federal Circuit has uniformly applied that principle since 1982. Thus, whatever "conflict" might once have existed with respect to this issue has long since been resolved against petitioner by the courts of appeals.

Warner-Jenkinson a reaffirmation of prosecution history estoppel only where a patentee amends her patent claims to avoid an examiner's rejection, and not where the patentee avoids the rejection by adopting a limited construction of her claims in argument to the examiner. In fact, the case did not involve or address patentee arguments at all. This Court discussed prosecution history estoppel arising from patent amendments simply because the patentee in *Warner-Jenkinson* had amended his claims, *see id.* at 1045-46; no party suggested that, and the Court had no reason to consider whether, other events in the prosecution history also could give rise to prosecution history estoppel.

Not only is petitioner's proposed rule unsupported by precedent, but the same policy considerations that underlie prosecution history estoppel by amendment underlie prosecution history estoppel by argument. Petitioner concedes that prosecution history estoppel is appropriate where a patentee amends a claim to overcome an examiner's rejection. (Pet. 13-14.) There is no substantive difference between that situation and a situation in which, as the district court and court of appeals found happened here, the patentee "relinquishe[s] coverage in order to obtain and preserve her patent." (Pet. App. A17.) Where a patentee assures an examiner that a particular element in her claims encompasses certain structures and not others, and the examiner accepts that assurance in ruling in the patentee's favor, the patentee cannot later be permitted to adopt a different view. Moreover, the patentee's assurances to the examiner are not private, offhand comments, but rather are part of the public record on which the public must be able to rely to determine the scope of the patentee's lawful monopoly.[4] *See Markman* v. *Westview Instruments, Inc.*,

[4] Among petitioner's other contentions, she complains that allowing prosecution history estoppel to be based upon patentee arguments to the PTO will result in "general" statements giving rise to "many potential (and unintended) estoppels." (Pet. 17.) Whether that is a legitimate concern in a case that truly involves only gen-

52 F.3d 967, 978-79 (Fed. Cir. 1995) (*en banc*), *aff'd*, 116 S. Ct. 1384 (1996). It is thus not estoppel-by-argument that "makes the true scope of patent claims much more uncertain," as petitioner contends (Pet. 19), but a contrary rule that would permit a patentee to disclaim her prior representations to the PTO.

The wisdom of the rule that patentee arguments may give rise to prosecution history estoppel is exemplified by this case. Petitioner repeatedly asserted in the PTO that her invention tears by means of *"perforations"* and repeatedly stated that tearable side seams were not "perforation means" and thus not within the scope of her invention. Petitioner obtained and preserved her patent based on these representations, which not only induced the examiner to rule in her favor but also put the public on notice of the scope of her monopoly rights. Petitioner cannot repudiate those representations now.

3. Finally, petitioner asks this Court to determine whether a patentee can be denied the benefit of 35 U.S.C. § 112, ¶ 6, which allows a claim element to be expressed in terms of the function the element performs rather than a definite structure,[5] merely "because she includes a single

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eral statements to the PTO is not an issue presented here, where the patentee repeatedly and specifically assured the examiner that her invention required "perforations" and that tearable, sonically bonded side seams were not the "perforation means" required by her patent. Thus, although petitioner asserts that "the most astonishing estoppels are being derived from attorney arguments" (Pet. 26), there is nothing "astonishing" about the finding of prosecution history estoppel in this case. Only petitioner's hyperbole is astonishing.

[5] Section 112, ¶ 6, was added to the Patent Code in 1952 in response to this Court's decision in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1 (1946). In *Halliburton*, the Court prohibited the use of means-plus-function language to describe the "most crucial element" of a patent claim because such elements were ambiguous and inconsistent with the statute. *Id.* at 9. In section 112, ¶ 6, Congress permitted means-plus-function elements and

word in the claims suggesting a possible structure for the element." (Pet. i.) Petitioner does not dispute that a claim element that recites a definite structure is not a means-plus-function element under 35 U.S.C. § 112, ¶ 6, but apparently contemplates some sort of arbitrary limit —based on the number of words used—on a court's ability to determine whether a claim element in fact discloses a definite structure. Not only does petitioner's word-count rule find no support in precedent or the language of the statute—which is limited to claim elements that set forth a "means or step for performing a specified function *without* the recital of structure," 35 U.S.C. § 112, ¶ 6 (emphasis added)—but examination of the Federal Circuit's opinion makes clear that the majority here relied on far more than just one word. Moreover, the majority's supposed failure to follow Federal Circuit precedent is nonexistent.

Petitioner asserts that the Federal Circuit improperly refused to apply the rule of claim construction embodied in 35 U.S.C. § 112, ¶ 6: that a claim element shall be treated as a means-plus-function element when it recites the function a particular component of the invention is to perform, without specifying the component's structure. Petitioner's primary concern appears to be that the majority supposedly did not recognize that the use of the word "means" in a patent claim triggers a presumption that the inventor sought to invoke section 112, ¶ 6. (Pet. 23.)

In fact, however, although the majority opinion did not use the word "presumption," the majority expressly recognized that "[p]atent drafters conventionally [invoke section 112, ¶ 6] by using the words 'means for' followed by a recitation of the function performed." (Pet. App.

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addressed the Court's concerns about ambiguity by limiting the permissible scope of such elements to structures disclosed in a patent's specification and their equivalents. *See Valmont Indus., Inc.* v. *Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993).

A13.)[6] The majority further recognized that whether section 112, ¶ 6, applies in a particular case is to be determined on "an element-by-element basis" and that "[m]erely because a named element of a patent claim is followed by the word 'means' . . . does not automatically make that element a 'means-plus-function' element," and that "[t]he converse is also true; merely because an element does *not* include the word 'means' does not automatically prevent that element from being construed as a means-plus-function element." (Pet. App. A13 (emphasis in original).) The court then analyzed petitioner's patent and its prosecution history to conclude that, in this case, "perforation means . . . for tearing" was not a means-plus-function element. (*Id.* at A16.)

In so concluding, the Federal Circuit did not rely on "a single word," as petitioner suggests. Rather, the majority emphasized that petitioner's "claim describes not only the structure that supports the tearing function, but also its location (extending from the leg band to the waist band) and extent (extending through the outer layer)," and concluded that "[a]n element with such a detailed recitation of its structure, as opposed to its function, cannot meet the requirements of the statute." (Pet. App. A14.)[7]

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[6] Although the majority thus recognized the presumption to which petitioner refers, it is doubtful that petitioner was entitled to any such presumption in this case. As the majority noted, the "drafter of claim 1 in [petitioner's] patent was clearly enamored of the word 'means': six of seven elements in that claim include the word 'means,' which occurs in the claim fourteen times." (Pet. App. A13-14.) The use of the term "means" in petitioner's patent thus appears to have been a drafting idiosyncracy of her counsel rather than a conscious decision to invoke section 112, ¶ 6.

[7] Petitioner suggests that because the text of section 112, ¶ 6, does not refer to location or extent, recital of location or extent could not take a claim element outside the scope of that provision (Pet. 23, n.5). Her suggestion that such recitals are irrelevant to the applicability of section 112, ¶ 6, is wholly without support and,

Searching for some issue worthy of this Court's review, petitioner argues that the majority's decision is "in conflict with prior decisions of the Federal Circuit itself." (Pet. 23.) The first case petitioner cites, *York Products, Inc.* v. *Central Tractor Farm & Family Center*, 99 F.3d 1568 (Fed. Cir. 1996), is virtually identical to this case. In *York*, the Federal Circuit confirmed that "mere incantation of the word 'means' in a clause reciting predominantly structure cannot evoke § 112, ¶ 6," and held on the facts of that case that, despite an element's use of the word "means," that element was not a means-plus-function element. *Id.* at 1574. Three of the other cases petitioner cites—*Sofamor Danek Group, Inc.* v. *DePuy-Motech, Inc.*, 74 F.3d 1216 (Fed. Cir. 1996); *Interspiro USA, Inc.* v. *Figgie International Inc.*, 18 F.3d 927 (Fed. Cir. 1994); and *Intellicall, Inc.* v. *Phonometrics, Inc.*, 952 F.2d 1384 (Fed. Cir. 1992)—do not even consider whether the claims at issue included recitals of structure sufficient to disqualify them from means-plus-function treatment. In those cases, the parties did not dispute that the claims contained means-plus-function elements and, thus, the Federal Circuit had no occasion to consider whether section 112, ¶ 6, should apply.

Finally, *Laitram Corp.* v. *Rexnord, Inc.*, 939 F.2d 1533 (Fed. Cir. 1991), does not stand for a contrary rule. The claim element in *Laitram* was a "means for joining said pluralities [of link ends] to one another so that the axes of said holes of said first plurality are arranged coaxially, the axes of said holes of said second plurality are arranged coaxially and the axes of respective holes of both pluralities of link ends are substantially parallel; . . ." *Id.* at 1535. The structural language in this element does not describe the "means for joining," but rather the desired configuration of the items to be joined *after* they are joined—*i.e.*, the function that the "means

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in any event, challenges only the manner in which the Federal Circuit applied the law to these facts.

for joining" element is to perform. Thus, even if a conflict among the Federal Circuit's own decisions were a subject worthy of this Court's attention, no conflict exists here, and the petition should be denied.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

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